As to independent claim 1, the Examiner states that *Pintar* teaches

> an apparatus 10 (Figs. 1 and 2 of Pintar) for restricting telephone calls, wherein apparatus 10 includes a microcontroller 100/101, read as the claimed controller, having storage means/RAM 200 and ROM 101, read as the claimed memory, piggybacked/connected thereto for storing call restriction data, i.e., list(s) of telephone numbers, and at least one call restriction, i.e., modes of operation. (Fig. 1, Abstract, Col. 3, lines 31 - 58, Col. 5, lines 22 - 39, Col. 6, lines 12 - 32 of Pintar).

(Office Action, p.2) Applicant respectfully disagrees.

First, claim 1 recites "a controller having memory for storing call restriction data and at least one call restriction procedure". Thus, claim 1 requires a memory that is an element of the controller and, further, that the memory stores two sets of information: call restriction data and at least call one call restriction procedure. In contrast, as described below, *Pintar* teaches a first memory (i.e., ROM) that forms part of the microcontroller 100/101 (i.e., microprocessor and piggyback ROM combination) and which stores instructions and a second memory (i.e., RAM 200) for storing data. This RAM is separate and apart from the microcontroller/ROM. As explained in *Pintar*

> Microcontroller 101, in its preferred embodiment, is a National Semiconductor COP 444 CP four-bit microprocessor and National Semiconductor NMC 27C16 piggyback ROM....combination. Connected to the microprocessor and piggyback ROM combination 101 is a ... random access memory storage device 200 through data and control bus 110.

Pintar, col. 4, lines 15-22

x x x

> The microprocessor and piggyback ROM combination 101 monitor the input signals from the DTMF 301 and pulse conditioning operational amplifier 302 and compare the input signals to reference signals located in RAM 200. When a valid signal is obtained, the ROM instructs the microprocessor as to the proper course of action. In the case of a telephone number, the microprocessor searches the RAM 200 for numbers which have been programmed into the RAM

> 200. Based on what the microprocessor finds, the ROM instructs the microprocessor to either allow, prohibit or time the telephone call. If the number is disallowed or prohibited, the ROM instructs the microprocessor to generate a disconnect signal....
>
> In the case where the microprocessor and piggyback ROM combination 101 detect a valid programming control signal, the ROM instructs the microprocessor to accept further programming signals which allow the user to program into RAM 200 up to 23 eleven digit telephone numbers.

Pintar, col. 5, lines 1-26. (underscoring added)

Based on the foregoing, *Pintar* does not teach or suggest a memory that forms part of the controller and which stores both call restriction data and call restriction procedures as recited by claim 1.

The Examiner also states "Pintar further teaches a signal conditioning means 300 (Fig. 1 of Pintar) which includes a dual tone multifrequency (DTMF) decoder 301 (Fig. 2 of Pintar), read as the claimed transceiver. (Col. 3, lines 41 - 58, Col. 4, lines 44 - 51 of Pintar)" Applicant respectfully disagrees.

Claim 1 recites, "a transceiver having conductors for receiving tone signals from and sending tone signals to the telephone line and conductors for sending digital signals to and receiving digital signals from said controller...." Nothing in *Pintar* discloses or teaches the "conductors" recited by claim 1. Further, unlike the transceiver of claim 1, nothing in *Pintar* teaches or discloses that the DTMF decoder 301 sends tone signals to the telephone line or receives digital signals from the "microcontroller". However, the Examiner states that:

> while not discussed in detail by Pintar, it is inherent that if a call is to be allowed, the signaling path must be reversed and the signal must be converted back from a digital signal to a DTMF tone signal for transmission to the central office exchange connected by lines 11 and 12. Therefore, Pintar inherently teaches that signal conditioning means 300 and DTMF decoder 301 also receive digital signals from

> microcontroller 100/101 and send tone signals to the telephone lines 11 and 12. This reverse process is necessary and inherent or else any dialed signals from a telephone would be trapped in apparatus 10.

(Office Action, p. 3) Applicant respectfully disagrees and submits that the Examiner has misunderstood the teaching of *Pintar*.

As discussed in detail below, what *Pintar* teaches is a call restricting apparatus connected between telephone lines 11, 12 leading to a central office and telephone lines 13, 14 leading to a telephone (See, *Pintar* FIGS. 1, 2) In case of a call to a prohibited telephone number ("prohibited call), the microcontroller instructs field effect transistors to disconnect the apparatus from telephone lines 11, 12 leading to the central office. This disconnects the telephone from the central office. In case of an allowed call, the microcontroller does not instruct the field effect transistors to disconnect the apparatus from the telephone lines. Instead, the microprocessor goes into an "idle mode" that allows the call to go through. Since the microcontroller goes into an "idle mode" in case of an allowed call, this means that the microcontroller does not send a digital signal to the signal conditioning means and DTMF decoder as the Examiner states. Consequently, the signal conditioning means and DTMF decoder do not send tone signals to telephone lines 11, 12 leading to the central office since they have received no instructions from the "idle" microcontroller. As *Pintar* explains in more detail:

> When a service request from the telephone set connected at telephone lines 13 and 14 enters the call restricting apparatus 10 through field effect transistors 503, 504 and 505, it is routed to the signal conditioning means 300. In the case of a touch tone signal, the tone is routed directly to the Silicon Systems SSI 204 dual tone multifrequency integrated circuit decoder 301, or commonly called a DTMF.... The DTMF 301 converts the dual frequency tone to a binary equivalent and sends the binary equivalent to microprocessor and piggyback ROM combination 101....
>
> The microprocessor and piggyback ROM combination 101 monitor the input signals from the DTMF 301 and pulse conditioning

> operational amplifier 302 and compare the input signals to reference signals located in RAM 200. When a valid signal is obtained, the ROM instructs the microprocessor as to the proper course of action. In the case of a telephone number, the microprocessor searches the RAM 200 for numbers which have been programmed into the RAM 200. Based on what the microprocessor finds, the ROM instructs the microprocessor to either allow, prohibit or time the telephone call. If the number is disallowed or prohibited, the ROM instructs the microprocessor to generate a disconnect signal via connection pin 105. Connected to pin 105 are control field effect transistors 503, 504 and 505, which in turn disconnect the call restricting apparatus 10 from telephone lines 11 and 12 through field effect transistors 501 and 502. If the number is allowed, microprocessor and piggyback ROM combination 101 shifts into an idle mode and allow the call to be completed.

Pintar, col. 4, line 44 to col. 5, 20.

Further, since *Pintar* teaches restricting telephone calls by disconnecting or not disconnecting the apparatus from the telephone, this means that dialed signals from the telephone go out of the apparatus and into telephone lines 11, 12 leading to the central office until and unless microcontroller 100/101 instructs field effect transistors to disconnect the apparatus from telephone lines 11, 12. Thus, there is no need to for reversing the signaling path as stated by the Examiner since signals from the telephone actually go to the telephone lines leading to the central office unless the apparatus is disconnected. Applicant also points out that if reversing the signaling path is inherent in *Pintar* as Examiner states, then, *Pintar* must teach a means for generating the dialed "pulses" (i.e., from a rotary telephone) for transmission from the apparatus to the central office, otherwise, any dialed pulses from a rotary telephone would be trapped in apparatus. However, nothing in *Pintar* discloses such a means. Thus, since "reversing the signaling path" is not inherent in *Pintar*, this reference does not teach or suggest that the DTMF decoder receives digital signals from the microcontroller or that the DTMF decoder sends tone signals to the telephone lines as the Examiner states.

Based on the foregoing, *Pintar* does not disclose or suggest a transceiver that sends tone signals to the telephone line and receives digital signals from the controller as recited in claim 1.

Applicants also point out that *Pintar* does not teach or suggest causing an interference on the telephone line. However, the Examiner states that:

> Rosen teaches such a method in a call defeat apparatus. (Abstract, Col.1, lines 45 - 67 of Rosen) It would have been obvious for one of ordinary skill in the art at the time the invention was made to have implemented applying a line interference on the telephone line instead of merely disconnecting the line inasmuch as both methods of restricting calls are very old and well known and choosing one method over the other is merely a design choice or preference.
>
> Moreover, see Figs. 1-3, Col. 2. line 22 - Col. 4, line 60 of Rosen and note that the functional elements of both apparatuses are identical or at the least very similar, i.e., a microcontroller/processor memory containing call restriction procedures and stored telephone numbers for comparison, functional means for transmitting and receiving tone/DTMF signals as well as digital signals. Again, because the purpose, end result, and design of Pintar and Rosen are at least functionally identical, and because either interference or disconnection are old and well known interchangeable methods for restriction devices, it would have been obvious to substitute one for the other in the invention of Pintar.

(Office Action, pp. 4-5) The Applicant respectfully disagrees.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. (MPEP 706.02(j), MPEP 2143) Here, the Examiner does not identify any such teaching, suggestion or motivation in *Pintar*, *Rosen*, or in the knowledge generally available to one of ordinary skill in the art. Neither does the Examiner make any finding "concerning the identification of the

relevant art, the nature of the problem to be solved or any other factual findings that might serve to support a proper obviousness analysis." *In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir.)

The Examiner's statement that it would have been obvious to combine *Pintar* with *Rosen* because choosing a method of call restriction is merely a design choice is supported only by Examiner's discussion of the similarities of the *Pintar* and *Rosen* and how their combination reads on claim 1. This is not sufficient to meet the above-mentioned requirement of MPEP2143. See, e.g., *In re Dembiczak*, 50 USPQ2d at 1618. ("Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Halliday and Shapiro references teach or suggest their combination with conventional ... bags to yield the claimed invention.")

Applicant also disagrees with Examiner's statement that "because the purpose, end result, and design of Pintar and Rosen are at least functionally identical ... it would have been obvious to substitute one for the other in the invention of Pintar." The *Pintar* and *Rosen* references are not functionally equivalent because they disclose different methods of operation. As discussed above, *Pintar* teaches preventing calls to prohibited telephone numbers by disconnecting the telephone from the telephone line. On the other hand, *Rosen* teaches preventing calls to prohibited telephone numbers by using DTMF tones to prevent the call from being completed or using audio tones to interfere with the call. (*Rosen*, col. 1, line 44-63). As discussed below, these two methods of operation creates significant differences in terms of design and end result.

As to end result, (i.e., preventing unauthorized calls); in *Pintar* the end result is a "disconnected" telephone. In *Rosen*, the end result is a "jammed" telephone line. This difference in the method of preventing unauthorized calls means that the design of an apparatus

for blocking prohibited calls would also be different depending on the method chosen. For example, since *Pintar* teaches disconnecting a telephone to prevent unauthorized calls, the apparatus of *Pintar* requires a power source for the microcontroller 100/101 and the RAM/storage device 200 when the telephone line is disconnected. (*Pintar*, col. 3, line 60-65). In contrast, *Rosen* has no such requirement since *Pintar* does not teach disconnecting the telephone line to prevent unauthorized calls. On the other hand, the apparatus of *Rosen* requires a dialer or audio oscillator to generate tones in order to produce the interference for preventing unauthorized calls. (See, *Rosen*, Abstract) In contrast, *Rosen* has no such requirement since it does not teach using interference to prevent unauthorized calls.

In light of the foregoing, *Pintar* and *Rosen* are not functionally equivalent. More importantly, since the method of operation for preventing unauthorized calls affects the design and end result of a device for blocking unauthorized calls, choosing one method over the other (i.e., disconnecting the telephone vis-à-vis causing interference) is not merely a design choice or preference as the Examiner states.

Applicant further points out that it would not have been obvious to combine *Pintar* and *Rosen* since these two references take mutually exclusive paths to reach different solutions to solve a similar problem. Thus, by implication each teaches away from being combining with the other. As discussed above, *Pintar* teaches preventing prohibited calls by disconnecting the telephone while *Rosen* teaches preventing prohibited calls by using tones to interfere with the prohibited call. Since *Pintar* and *Rosen* teach away from each other, it would not be logical to combine them.

In addition, since *Pintar* and *Rosen* have different methods of operation, neither reference can be modified to function in the same manner as the other. This is because under

MPEP 2143.01, the proposed modification cannot change the principle of operation of a reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01, citing *In re Ratti*, 270 F.3d 810, 123 U.S.P.Q. 349 (CCPA 1959).

In summary, the combination of *Rosen* and *Pintar* fails to disclose all of the limitations of recited in claim 1 and the Examiner has not pointed out any suggestion or motivation in the two references or in the knowledge generally available to one of ordinary skill in the art to combine these two references as required by MPEP 706.02(j), MPEP 2143. Further, as discussed above, it would not have been obvious to combine or modify these two references. Therefore, Applicant submits that the obviousness rejection of claim 1 should be withdrawn. Claims 2-6, 9, 10, 26 and 27 depend from claim 1 and are allowable for the same reasons claim 1.

In addition, claim 6 recites "a circuit for supplying power to said controller and to said transceiver only when a telephone off hook condition is detected on the telephone line." As explained in the specification, this means the call restriction device "is supplied with electrical power from the telephone line 4 only when the telephone 2 is off hook" (Specification, p. 8, lines 4-6). The call restriction device "consumes power only when the telephone is off hook and does not require a separate power supply, such as a battery or external power supply. Thus the call restriction device does not operate unless a positive seizure of the telephone line it is installed on occurs." (Specification, p. 9, lines 23-28) No such limitation is disclosed or suggested in *Pintar* or *Rosen*.

However, the Examiner states that *Pintar*

> teaches circuitry wherein power supply 201 (Figs. 1 and 2 of Pintar) bleeds off current from telephone lines 11-14 (Figs. 1 and 2 of Pintar) and that when the telephone goes off-hook, backup power source 202 is prevented from sending power to power supply 201. (See the rejection of claim 5) Therefore, in essence, because power supply 201 is used to power RAM 200, apparatus 10 is only really powered during an off-hook condition when the telephone itself is receiving power from the telephone lines 11 - 14 as is standard
>
> Even interpreted differently, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have allowed for supplying power only during an off-hook condition because this is the only time when power is needed to operate the entire apparatus 10. The only time apparatus 10 is operated is when a call is going to be made or apparatus 10 is going to be programmed, i.e., during an off-hook condition. Therefore, a common motivation of saving power consumption would also make it obvious to receive power only during an off-hook condition.

(Office Action, page 6-7) Applicant respectfully disagrees.

Applicant submits that the Examiner has misunderstood the teaching of *Pintar*. According to *Pintar*: "During an on-hook condition, the random access memory storage device 200 is powered by power supply 201 by bleeding off a small current from phone lines 11, 12, 13 and 14...." (*Pintar*, col. 4, line 24-27). Thus, during an on-hook condition, the random access memory (RAM) storage device 200 of *Pintar* is, in fact, powered from the telephone lines. Since RAM storage device 200 forms part of the apparatus of *Pintar*, it follows that apparatus 10 is actually powered and consuming power during an on-hook condition. Further, since *Pintar* teaches that the apparatus 10 must be powered during both an off-hook and an on-hook condition, *Pintar* actually teaches against supplying power only during an off-hook condition as recited in claim 6. Therefore, *Pintar* does not teach or suggest the limitation recited in claim 6.

In ¶3 of the Office Action dependent claims 7 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Pintar* in view of *Rosen* and further in view of U.S. Patent No. 5,471,524 to Colvin ("*Colvin*"). Applicant respectfully traverses this ground of rejection.

As previously discussed above, the combination of *Pintar* and *Rosen* fails to disclose all of the limitations of claim 1 and, consequently, all of the limitations of claim 7 and 8, which depend from claim 1. As such, combining *Pintar* and *Rosen* with *Colvin* does not render claims 7 and 8 obvious.

The Examiner also states that Colvin:

> teaches another call restrictive apparatus ... that sets disconnect/reset time period long enough to avoid hook flash tricks. (Figs. 2b and 3, Col. 4, line 27 - Col. 8, line 18, Col. 9, lines 1 - 24 of Colvin et al.) Therefore, for the same reasons why it would have been obvious for one of ordinary skill in the art at the time the invention was made to have combined Pintar and Rosen, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have allowed for detecting quick on-hook conditions and maintaining interference in the invention of Pintar and Rosen.

(Office Action, pp. 8-9) Applicant respectfully disagrees and submits that the Examiner has misunderstood the teaching of *Colvin*.

The reset timing circuit of *Colvin* is not directed towards preventing the use of a hook flash to "trick" a call restrictive apparatus. Rather, the reset timing circuit ensures that the telephone is disconnected from the central office for a period of time sufficient for the central office to perceive the disconnection as hang-up rather than the "flash signal" used for services such as call-waiting or third-party calling. (*Colvin*, col. 9, line 1-24).

In fact, what *Colvin* actually teaches is a call restrictor apparatus that prevents an unauthorized call by going into a disconnect-reconnect-disconnect loop (*Colvin*, col. 11, line 9-13; FIG. 4). Specifically, a microprocessor interacts with transistors, resistors and with capacitors that alternately discharge and charge during the disconnect-reconnect loop. The microprocessor, using resistors and transistors, disconnects the telephone during the initial dialing of the prohibited telephone number. When certain capacitors discharge below a certain level, the reset timing circuit re-connects the telephone to the central office telephone line and these capacitors are re-charged. However, since the restrict flag is still set in the program, the microprocessor again does a disconnect and the loop begins again. This loop is virtually a continuous disconnect and the loop will continue the telephone is hung up and remains hung up (i.e., on hook) for several seconds and the whole system is "powered down", i.e., the loop is broken because the capacitors become fully discharged and cannot be re-charged since the telephone is on hook. See: *Colvin*, col. 5, line 10 to col. 6, line 6; col. 7, line 63 to col. 8, line 18; col. 8, line 56 to col. 9, line 46.

Thus, it is not the "reset time period" which defeats hook flashes, as the Examiner would suggest. Rather, it is the disconnect-reconnect-disconnect loop which defeats hook flashes since loop cannot be broken until a hang up period of sufficient time to "power down" the system takes place. Therefore, the actual length of the reset period is irrelevant to defeating hook flashes.

Based on the foregoing, nothing in *Colvin* teaches or even suggests "maintaining the interference on said telephone line until a telephone on hook condition of sufficient duration is detected" as recited by claim 7. Neither does *Colvin* teach or suggest ceasing the interference in response to detection of an on-hook condition and resuming the interference on said

telephone line following a telephone on hook condition of insufficient duration as recited by claim 8.

In addition, it would not have been obvious to combine *Pintar, Rosen* and *Colvin* since these three references take mutually exclusive paths to reach different solutions to solve a similar problem. Therefore, by implication each reference teaches away from being combined with the others. Specifically, *Pintar* teaches disconnecting a prohibited call, *Rosen* teaches using tones to interfere with a prohibited and *Colvin* teaches using a disconnect-connect-disconnect loop to prevent prohibited calls. Further, since these three references have different methods of operation, none of them can be modified to function in the same manner as the others. See, MPEP 2143.01 (*supra*)

In ¶4 of the Office Action, the Examiner rejected claims 12, 13 and 19 under 35 U.S.C. 103(a) as being unpatentable over *Pintar*. The Applicant respectfully traverses this ground of rejection.

As to independent claims 12 and 19, the Examiner refers to his earlier statements relating to *Pintar* and also his rejection of claim 1. Applicant disagrees with the Examiner and submits that the obviousness rejection of claims 12 and 19 should be withdrawn based on the Applicant's arguments above relating to *Pintar* and the rejection of claim 1. In addition, claim 13 depends from claim 12 and is allowable for the same reasons as claim 12.

Applicants also point out that the term "remote computer" recited in claim 12 (and also in claim 21) refers to a computer that is connected to the public telephone switching network ("PTSN") via a local exchange that is different from the local exchange of the telephone line on which the call restrictor is connected. (See, Specification at page 4, line 4-6 and page 8, lines 1-24.) Claim 12 further recites that signals representing call restriction data

and call restriction procedures are sent into the telephone line from the telephone to the remote computer, and then signals representing corresponding programming code are sent into the same telephone line from the remote computer to the call restriction device. Thus, claim 12 requires that signals pass from the telephone to the remote computer and then to the call restriction device via the PTSN. These limitations are nowhere disclosed or suggested in *Pintar*.

However, the Examiner states that while *Pintar* does not teach using a remote computer for programming, *Pintar* teaches that "control of apparatus 10 is effected through signals sent on the telephone line and direct contact with a telephone connected to the telephone (*sic*) not needed." (Office Action, page 10) Applicant respectfully disagrees and submits that Examiner has misunderstood the teaching of *Pintar* and the limitations recited by claim 12.

What *Pintar* actually teaches is that apparatus 10 is programmed by entering numbers on the telephone which are routed via telephone lines 13, 14 (Note: not telephone lines 11, 12 which lead to the central office) to the signaling conditioning means and then to the controller (See, *Pintar*, col. 4, line 44-67; col. 6, line 3-22 and FIGS. 1, 2). *Pintar* also teaches that the apparatus 10 can be programmed using an external serial device directly connected to a serial data port on the apparatus. (*Pintar*, col. 6, line 51-62). However, nothing in *Pintar* teaches or suggests that the telephone, apparatus or a "remote" computer exchange signals via the PSTN as required by claim 12 or that the apparatus can even communicate with another device over the PSTN.

The Examiner also states that *Pintar* "does teach using an external serial device with means for displaying digital information to program apparatus 10, which could be a computer, although arguably not 'remote' since this device is directly connected to apparatus 10" and that "it would have been obvious ... to have allowed for remote computer access

inasmuch as this would only require replicating the local computer functionality at a remote computer." Applicant respectfully disagrees.

What *Pintar* teaches is that apparatus 10 can be programmed by using an external serial device directly connected to the apparatus. However, it does not follow from this that allowing for remote computer access is merely a matter of "replicating the local computer functionality at a remote computer". As discussed above, nothing in *Pintar* teaches or suggests that the telephone, apparatus and external serial device can communicate with each other over the PSTN or they are even capable of doing so.

In ¶5 of the Office Action, claims 14-19, 21, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Pintar* in view of U.S Patent No. 5,864,613 to *Flood*. Applicant respectfully traverses this ground of rejection.

As to dependent claims 14 and 15, the Examiner refers to his previous discussions of *Pintar* in relation to claims 12 and 13 and further states that while *Pintar* "does not teach a remote computer embodied as an interactive voice response unit which would allow for voice prompts to be sent" this is taught by *Flood*. Applicant respectfully disagrees.

Claims 14 and 15 depend from claim 12. As previously discussed by Applicant above, *Pintar* fails to disclose all of the limitation of parent claim 12. Thus, despite any teaching of *Flood* relating to voice prompts, the combination of *Pintar* and *Flood* does not render claim 14 and 15 obvious because the resulting combination still fails to disclose all of the limitations of parent claim 12 which are necessarily included in dependent claims 14 and 15. Therefore, the combination of *Pintar* and *Flood* does not render claims 14 and 15 obvious and the rejection should be withdrawn.

As to claims 16-18, 21, and 22, the Examiner refers to his rejections of claims 10, 12 and 15. Applicant disagrees with the Examiner and submits that the rejection should be withdrawn based on the arguments previously discussed by Applicant above with respect to claims 10, 12 and 15.

Also, independent claim 16 recites an interactive voice response (IVR) system "having an access number that is accessible via a public telephone switching network" and independent claim 21 recites a "remote computer", which, as previously discussed above, is computer that is connected to the PTSN via a local exchange that is different from the local exchange of the telephone line on which the call restrictor is connected. Further, both claim 16 and 21 require that the call restrictor device and IVR/remote computer send signals/communicate via the PSTN. None of these limitations are disclosed or suggested by *Pintar* or *Flood.*

The Examiner, however, states that:

> if one is remotely programming apparatus 10 he/she must be using a remote computer/IVR to connect to the telephone line apparatus 10 is connected to. There would be no other way to effect programming signals on that line. Remember above, that Pintar teaches programming apparatus 10 via signals received on the telephone lines 11-14 connected thereto.

(Office Action, page 12) Applicant respectfully disagrees.

As Applicant previously discussed above in relation to claim 12, nothing in *Pintar* teaches or suggests that apparatus 10 is remotely programmed by sending signals through the PSTN or that the apparatus can even communicate with another device via the PSTN. Thus, nothing in *Pintar* teaches or suggests the IVR recited in claim 16 or the remote computer recited in claim 21.

Based on the foregoing, the combination of Pintar and Flood does not render claims 16 or 21 obvious. Claims 17-18 and claim 22 depend respectively from claims 16 and 21 and are allowable for the same reasons as their parent claims.

In ¶6 of the Office Action, claims 23 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Pintar*, *Rosen* and further in view of *Flood*. The Applicant respectfully traverses this ground of rejection.

In support of the rejections, the Examiner refers to the rejections of claims 1 and 3. Applicant submits that the rejections must be with withdrawn based on Applicant's previous arguments above with respect to claims 1 and 3.

The Examiner also states that:

> it is inherent that microcontroller 100/101 of Pintar or controller 6 of Rosen would have to send another signal to autodialer 7 of Rosen to increase intensity of the interference signal. Both microcontrollers are the brains of the call restrictive apparatus and so any changes must be initiated by the microcontroller and hence another signal, read as the claimed second signal, the claimed first signal being merely the signal the microcontroller fist [*sic*] sends to autodialer 7 to transmit an interference signal.

(Office Action at page 13) Applicant respectfully disagrees.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. MPEP 706.2(j) Nothing in *Pintar*, *Rosen* or *Flood* teaches or discloses sending more than one signal or sending a first signal and second signal or even provides any suggestion or motivation to modify *Rosen*. In fact, *Rosen* already teaches that the intensity of the tone placed on the line is "sufficiently loud as to totally disrupt any attempt at communication in

the line...." (*Rosen*, col. 4, lines 39-42) which precludes any need, suggestion or motivation for a first and second signal or a two-step process that the Examiner describes.

In addition, claim 21 recites a circuit that increases the amplitude of the DTMF signals and claim 25 recites a DTMF transceiver having a port for outputting DTMF signals in both the programming mode and the call inhibition mode. No such limitations are disclosed in *Pintar, Rosen* or *Flood.* Based on the foregoing, claims 23 and 25 are allowable.

Finally, the Examiner states that "IVRs and remote control are very old and well known in the telephony arts and those skilled in the art would clearly know how to implement an IVR in the systems of Pintar, Rosen, and/or Colvin et al." (Office Action, ¶7).

Applicant submits that regardless of whether or not IVRs and remote control are well-known in the relevant art and to those skilled in the relevant art, MPEP 2143 still requires that in order to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings." Here, Examiner has not identified any teachings or suggestions "to implement an IVR in the systems of Pintar, Rosen, and/or Colvin et al."

For the reasons set forth above, reconsideration of the application and allowance of claims 1-10, 12-19, 21-23, and 25-27 are hereby requested by the Applicant.

Respectfully submitted,

October 26, 2004
Date

Dennis M. Flaherty
Reg. No. 31,159
Ostrager Chong Flaherty and
Broitman P.C.
250 Park Avenue, Suite 825
New York, New York 10177-0899
Tel. No.: (212) 681-0600

CUSTOMER NO. 44702

CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date set forth below.

October 26, 2004
Date

Dennis M. Flaherty